



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Group Art Unit 2876

In re

Patent Application of

Binh T. Lu, et al.

Application No. 10/725,047

Confirmation No.: 2957

Filed: December 1, 2003

Examiner: Caputo, Lisa M.

"POSTAL STAMP TRACKING SYSTEM
AND METHOD"

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is a Replacement Appeal Brief in the above-identified application.

A return receipt postcard.

In the event Applicants have overlooked the need to request an extension of time, please consider this a request for the same.

The required \$500.00 fee was previously submitted on March 18, 2005 with the original Notice of Appeal, therefore no additional fee is being submitted at this time. However authorization is given to charge or credit Deposit Account No. 13-3080 with any shortage or overpayment of the fees associated with filing the Appeal Brief or the Appeal. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

C-72
Casimir F. Laska
Reg. No. 30,862

File No. 061151-9010-00
Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Milwaukee, Wisconsin 53202-4108
262.956.6507



THE UNITED STATES PATENT AND TRADEMARK OFFICE
Group Art Unit 2876

In re

Patent Application of

Binh T. Lu et al.

Application No. 10/725,047

Confirmation No. 2957

Filed: December 1, 2003

Examiner: Caputo, Lisa M.

"POSTAL STAMP TRACKING SYSTEM AND
METHOD"

I, Molly Seymour, hereby certify that this correspondence is being deposited with the US Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date of my signature.


Signature


Date of Signature

REPLACEMENT APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants provide this Replacement Appeal Brief in response to the Notice of Non-compliant Appeal Brief dated May 16, 2006. The Replacement Appeal Brief is in response to the Office action dated August 24, 2005, in which the Examiner reopened prosecution. As stated in MPEP 1208.02, Applicants can file a reply to the Office action issued by the Examiner or can request reinstatement of the appeal. Applicants hereby request reinstatement of the appeal and provide this Replacement Appeal Brief, as required under 37 C.F.R. § 1.193(b)(2)(ii).

Applicants originally appealed from the final rejection dated October 19, 2004 and the Advisory Action dated March 17, 2005. Applicants note that a Notice of Appeal was filed March 18, 2005 and received by the Patent Office on March 21, 2005. Applicants have

previously paid the fee required under 37 CFR 41.20(b)(2). However, if any additional fee is due, please charge or credit deposit account No. 13-3080 with any underpayment or overpayment of fees.

Applicants also respectfully submit that reopening prosecution without a new ground of rejection is improper. MPEP §1208.02 states:

The examiner may, with approval from the supervisory patent examiner, reopen prosecution to enter a new ground of rejection after appellant's brief or reply brief has been filed. The Office action containing a new ground of rejection may be made final if the new ground of rejection was (A) necessitated by amendment, or (B) based on information presented in an information disclosure statement under 37 CFR 1.97(c) where no statement under 37 CFR 1.97(e) was filed. See MPEP § 706.07(a).

MPEP 1208.02. However, in the Office action dated August 24, 2005, the Examiner cited no new references or grounds for rejection. Rather, the Examiner attempted to strengthen the same arguments presented in the final rejection dated October 19, 2004. The Examiner stated as much noting “[t]he same references are used in the rejection, however, the motivation to combine the references has been elaborated upon.” *Office action dated August 24, 2005, page 2*. It is these arguments that the Applicants disagree with and have appealed. As such, the Examiner should have presented these arguments in the Examiner’s reply brief. The reopening of prosecution, without a new ground of rejection, does nothing but further delay the prosecution of this application.

(1) Real Party in Interest.

The real party in interest is Lockheed Martin Corporation, 6801 Rockledge Drive, Bethesda, MD 20817, and its Lockheed Martin Systems Integration Division, of Owego, New York.

(2) Related Appeals and Interferences.

There are no related appeals or interferences.

(3) Status of Claims.

Claims 1, 3-7, 11-20, and 22-28 are pending and are included in Appendix A of this paper. Claims 1, 3-7, 11-20, and 22-28 stand rejected by the Examiner. Applicants appeal the rejection of claims 1, 3-7, 11-20, and 22-28.

(4) Status of Amendments.

There are no outstanding amendments. The amendment filed February 14, 2005 has not been entered.

(5) Summary of Claimed Subject Matter.

In one construction, illustrated in Fig. 1, the invention defines a trackable postage stamp (10) that includes a first surface (15), and a second surface (20) opposite the first surface (15) and adapted to adhere to a piece of mail (25). *Specification, pg. 3, lines 2-5.* The postage stamp (10) also includes a passive tracking device (30) including a stamp identification number. *Specification, pg. 3, lines 2-9.* In one construction, the passive tracking device (30) includes a radio frequency identification device (RFID). *Specification, pg. 3, lines 8-9.* Figs. 3, 4 and 7 illustrate another aspect of the invention. Figs. 3 and 4 illustrate a stamp dispensing system (40) that is suited to dispensing stamps (10) as illustrated in Fig. 1 and/or books of stamps (55) as illustrated in Fig. 7. *Specification, pg. 8, lines 4-7.* The stamp dispensing system (40) includes a stamp dispenser (40) that includes a plurality of postage stamps (10) and dispenses a product

(stamp (10), book of stamps (55), roll of stamps, etc.) in response to a purchaser. *Specification*, pg. 8, lines 9-17. As the product discharges from the machine, the product passes a reader (35) that reads the passive RFID device (30). *Specification*, pg. 8, lines 17-19. In another aspect of the invention, the stamp dispenser (40) includes an imaging device that captures an image of the user of the dispenser. *Specification*, pg. 10, lines 15-17.

In yet another aspect, the invention discloses a method of tracking a postage stamp (10). The stamp (10) is dispensed and data is read from the RFID tag (30). *Specification*, pg. 8, lines 17-21. The data can be stored within the vending machine (40) or transmitted to a central database. *Specification*, pg. 8, line 22 through pg. 9, line 2. As shown in Figs. 5-6, a mailbox (45) also includes a reader (35a). *Specification*, pg. 9, lines 3-4. The reader (35a) reads the tracking device (30) as the mail is deposited. *Specification*, pg. 9, lines 4-6. The mailbox (45) may include storage media (85a) for storing the read data or may include a wired or wireless transmitter (90a) for transmitting the read data to the central database. *Specification*, pg. 9, lines 9-13. In some constructions, an indicator is employed to notify postal workers that an envelope was sensed but the RFID tag (30) was not read. *Specification*, pg. 9, lines 20-22.

The data within the database can be analyzed to look for patterns or individuals based on the stamps (10) they use. *Specification*, pg. 11, lines 14-15. In one example, the system identifies stamps (10) that are deposited into the postal system (e.g., via a mailbox (45)) at a distance that is greater than a predefined distance from the location from which the stamp (10) was purchased. *Specification*, pg. 11, lines 15-17.

(6) Grounds of Rejection to be Reviewed on Appeal.

Whether the Examiner erred in refusing to enter the amended claims filed February 14, 2005. In addition, whether claims 1, 3-7, 11-20, and 22-28 are patentable under 35 U.S.C. §103(a) over various combinations of Tuttle (U.S. Patent No. 5,497,140), Conwell (U.S. Patent Application No. 2002/0135481), Porter (U.S. Patent No. 5,774,053), Barcelou (U.S. Patent No. 6,048,271), Levasseur (U.S. Patent No. 4,008,792), and Fite (U.S. Patent No. 6,467,684).

(7) Argument.

I. The Examiner Erred by Failing to Enter the Claims of the February 14, 2005 Amendment

Applicants submit that the Examiner erred by not entering the February 14, 2005 Amendment.

Amendments made to expedite resolution of a case made at any time after final rejection, but before jurisdiction has passed to the Board may be entered so long as the amendment conforms with the requirements of 37 C.F.R. 1.116. *See MPEP §1207.* Examples of amendments that will not be entered include amendments that necessitate a new search, raise the issue of new matter, present additional claims without canceling a corresponding number of finally rejected claims, or otherwise introduce new issues. *MPEP §1207.*

The Examiner argues that the claim amendments were not entered because “[t]he additional limitation of ‘without an onboard power supply’ (or ‘does not include an onboard power supply’) that was inserted into each of the independent claims (claims 1, 11, and 19) is a new issue that was not considered prior to the final rejection and hence requires further consideration and search.” *Advisory Action dated March 17, 2005, pg. 3.*

Applicants disagree with this conclusion. Prior to the amendment, claims 1, 11, and 19 included the limitation of a passive tracking device or a passive RFID device. RFID tags are generally classified into two broad groups, passive and active. *See Applicant's specification, pg. 3, line 10.* Applicants discuss the difference between passive and active RFIDs, stating “[p]assive tags do not include a power supply of their own, while active RFID tags include a power supply such as a battery.” *See Applicant's specification, pg. 3, lines 11-12.* Thus, Applicants’ disclosure clearly would require that the Examiner’s search include RFIDs that do not include a power supply. This search would necessarily encompass passive RFIDs that do not include an onboard power supply. Applicants contend that the amendment simply makes explicit that which is already part of the definition of the term “passive RFID.” Applicants believe the Examiner erred in not entering the amendments.

II. Substantive Claim Rejections

To establish a *prima facie* case of obviousness, the Examiner must meet three basic criteria. *See M.P.E.P. § 706.02(j) and 2143.*

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be both found in the prior art, not in applicants’ disclosure.

Id. The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventors have done. *M.P.E.P. § 706.02(j); see also In re Rougget, 149 F.3d 1350, 1355 (Fed. Cir. 1998).* In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led

to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from Appellant's disclosure. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 U.S.P.Q.2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); In re Vaeck, 947 F.2d at 493, 20 U.S.P.Q.2d at 1442; MPEP §2143. The Examiner can only establish a *prima facie* case of obviousness by pointing out some objective teaching in the prior art references themselves that would lead one of ordinary skill in the art to combine the relevant teachings and the references. In re Fine, 837 F.2d at 1074, 5 U.S.P.Q.2d at 1598-99; In re Jones, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1943-44 (Fed. Cir. 1992); MPEP §2143.01. "Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." ATD Corp. v. Lydall, Inc., 159 F. 3d 534, 546 (Fed. Cir. 1998).

In addition, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. In re Gordon, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984); In re Mills, 916 F.2d 680, 682, 16 U.S.P.Q.2d 1430, 1432 (Fed. Cir. 1990); MPEP §2143.01.

Further, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d at 902, 221 U.S.P.Q. at 1127 (Claimed device was a blood filter assembly for use during medical procedures wherein both the inlet and outlet for the blood were located at the bottom end of the filter assembly, and wherein a gas vent was

present at the top of the filter assembly. The prior art reference taught a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a pet-cock (stopcock) was located at the bottom of the device for periodically removing the collected dirt and water. The reference further taught that the separation is assisted by gravity. The Board concluded the claims were *prima facie* obvious, reasoning that it would have been obvious to turn the reference device upside down. The court reversed, finding that if the prior art device was turned upside down it would be inoperable for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline, and the screen would become clogged.); *MPEP §2143.01*.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). *MPEP 2143.01*.

To properly establish a *prima facia* obviousness rejection under 35 U.S.C. §103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

MPEP §2142. Thus, hindsight based on the applicant's disclosure cannot be used to establish an obviousness rejection. *See id.*

A – Rejection of claims 1 and 3-7 under 35 U.S.C. §103(a) as being unpatentable over Tuttle (U.S. Patent No. 5,497,140) in view of Conwell et al. (U.S. Patent Publication No. 2002/0135481).

i: Claims 1 and 4-7

Claims 1 and 4-7 are patentable separately from the other claims because these claims do not include all the limitations of the other claims and because these claims recite, *inter alia*, a stamp that includes a passive tracking device. More specifically, claims 1 and 4-7 are patentable because the references cited by the Examiner, alone or in combination, fail to teach or suggest all of the claimed limitations, as described below in more detail.

Claim 1 defines a trackable postage stamp comprising a first surface and a second surface opposite the first surface and adapted to adhere to a piece of mail. The stamp also includes a passive tracking device that includes stamp identification (ID) information.

Tuttle discloses an electrically powered postage stamp or mailing label that includes a powered RFID device and system. The RFID system includes an IC chip, a RF antenna, and batteries, thus defining an active RFID system and not a passive system.

Conwell does not cure the deficiencies of Tuttle. Conwell discloses a tamper-resistant label that includes a passive RFID transponder. The RFID transponder is sandwiched between a substrate and an adhesive with a tamper-resistant cover. Conwell does not teach or suggest applying passive RFID transponders, or any passive tracking device, to postage stamps or mailing labels. All Conwell teaches is that passive RFID transponders exist.

Active RFIDs and passive RFIDs are very different components. As stated in Applicants specification:

RFID tags are generally classified into two broad groups, passive and active. Passive tags do not include a power supply of their own, while active RFID tags include a power supply such as a battery. Active RFID tags are typically able to be read from greater distances when compared to passive RFID tags. In addition, active tags can typically store and transmit more information than can passive RFID tags. However, active RFID tags are typically larger and more expensive than passive RFID tags. In addition, active RFID tags have a limited life span due to their need for an internal power supply.

Specification, page 3, lines 10-17. As such, the applications that use one type of RFID will not necessarily work if the other type of RFID is employed. Thus, absent a specific teaching or suggestion, one of ordinary skill in the art would not automatically assume that an application that employs an active RFID would also work using a passive tracking device, such as a passive RFID.

Applicants find no suggestion or motivation, in either Tuttle or Conwell, that would lead one of ordinary skill in the art to combine the teachings of Tuttle and Conwell. Conwell teaches nothing regarding the use of passive tracking devices in an item such as a postage stamp. The Examiner cites Conwell only for the teaching of a passive RFID on a label. Tuttle teaches the use of an active RFID and teaches away from the use of passive tracking devices such as passive RFIDs. Specifically, Tuttle states:

[The] prior art also includes smaller passive RFID packages which have been developed in the field of transportation and are operative for tracking automobiles. These reflective passive RFID packages operate by modulating the impedance of an antenna, but are generally inefficient in operation, require large amounts of power to operate, and have a limited data handling capability.

Tuttle Specification, col. 1, lines 61-67. The fact that Tuttle only discusses drawbacks of passive RFIDs would lead one of ordinary skill in the art to conclude that Tuttle believed passive tracking devices such as passive RFIDs were not suitable for a postage stamp or mailing label application.

In the Office action dated October 19, 2004, the Examiner argues that Tuttle discloses that passive RFIDs can be used to track small objects. The Examiner further argues, “in fact, Tuttle discloses alternatives to using a battery in the stamp embodiment (i.e., optical devices as recited in col. 7).” *Office action dated October 19, 2004, page 14.* Tuttle further states, “the present invention also includes forming an optical detector on the IC chip as a means of receiving and detecting signals carried by light and also as a means of powering the RFID transceiver as an alternative to using a battery.” *Tuttle Specification, col. 7, lines 27-31.* Furthermore, Tuttle discloses that RF charging may be employed in place of a battery. *See Tuttle Specification, col. 7, lines 8-9.* While Tuttle does disclose alternatives to batteries, Tuttle does not describe a passive tracking device or passive RFID as that term is defined in the specification and as that term is known in the art. Tuttle’s first alternative is to use an optical detector as a means of powering the RFID. This is akin to using a solar cell or solar power to power the RFID device. Thus, while it is not a battery, it is still an onboard power supply used exclusively by the particular RFID. Tuttle’s second alternative relates to the use of RF charging. While Tuttle states that this eliminates a battery, it still requires an element to be charged, such as a capacitor. Thus, the RFID still includes an onboard power supply used exclusively by the RFID, and as such is an active RFID.

In light of the foregoing, Applicants argue that Tuttle only teaches the use of active RFIDs, as that term is defined in the specification and understood in the art. Tuttle teaches alternatives to a battery, however, each of these alternatives still provides an onboard power source for each RFID. Thus, the RFIDs of Tuttle are all active and there is no teaching or suggestion within Tuttle that would lead one to combine the teachings of Tuttle and Conwell. Thus, the Examiner has failed to show a teaching or suggestion, from within the references

themselves and without the use of impermissible hindsight, that would lead one of ordinary skill in the art to combine Tuttle and Conwell. *See MPEP §2142 (discussing examiner's requirement to avoid the use of impermissible hindsight to assure that the conclusion of obviousness is based on facts gleaned from the prior art).*

Furthermore, even if one of ordinary skill in the art did combine the teachings of Tuttle with those of Conwell, there is no reasonable expectation of success. Tuttle discloses many of the disadvantages associated with using passive RFIDs in a mailing label or postage stamp application but never describes any solutions to these disadvantages. Conwell simply describes a passive system and makes no mention of its applicability to a postage stamp application. Thus, one of ordinary skill in the art, upon reading Tuttle, would conclude that passive tracking devices such as RFIDs are not suitable for a postage stamp.

Even the Examiner does not argue that the combination of Tuttle and Conwell would lead one to a postage stamp with a passive tracking device (i.e., no on board power supply). Rather, the Examiner states “it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a passive tracking device as disclosed by Conwell *in addition to* an active tracking device.” *Office action dated August 24, 2005, page 4 (emphasis added).* Such a combination would require two separate RFIDs, thus at least doubling the added cost of each stamp. In addition, two separate readers would be required wherever it is desirable to read the RFIDs because different types of readers are required for passive and active RFID devices. Readers for passive RFIDs must activate the RFID and provide power to the RFID so that the RFID can transmit information. Thus, the transmission is weak, when compared to the transmission of an active RFID. The weak transmission significantly reduces the range of reception. Active RFID readers on the other hand, can read active RFIDs from a longer distance

as no power transfer is required. The need for both types of RFIDs in the stamps and both types of readers at all of the reading locations would greatly increase the cost and complexity of the system and would likely make it cost prohibitive. A combination of elements that results in a device completely unsatisfactory for the desired task (due to lack of functionality or excessive cost) cannot be obvious. See In re Gordon, 733 F.2d at 902, 221 U.S.P.Q. at 1127.

For these reasons, Applicants submit that Tuttle and Conwell alone or in combination do not teach or suggest the subject matter defined by claim 1. Accordingly, claim 1 is allowable. In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 1 and allowance of claim 1. Claims 4-7 depend from claim 1 and are also allowable for these reasons.

The arguments presented above are applicable to claims 1 and 4-7 as they appear without the amendment filed February 14, 2005. Had the Examiner entered this amendment, as Applicants contend should have been done, the phrase “without an onboard power supply” would be included in claim 1. While this phrase adds nothing that is not inherently present in the claim language as it is now, the limitation would have clarified the meaning of “passive” and would have clarified the issues for this appeal. As such, Applicants contend the Examiner should have entered the amendment filed February 14, 2005.

ii. **Claim 3**

Claim 3 depends from claim 1 and specifically recites that the passive tracking device includes a radio frequency identification (RFID) device. The arguments presented with regard to claims 1 and 4-7 are equally applicable to claim 3. As discussed with regard to claims 1 and 4-7, Tuttle and Conwell, alone or in combination, do not teach or suggest a passive tracking device,

much less a passive RFID as recited in claim 3. Specifically, Tuttle discloses the use of an active RFID system and discusses the negatives of the passive systems. Conwell discloses the existence of passive RFID systems but makes no mention of their application to mailing or stamp applications. The Examiner has failed to show a teaching or suggestion, from within the references themselves and without the use of impermissible hindsight, that would lead one of ordinary skill in the art to combine Tuttle and Conwell. *See MPEP §2142 (discussing examiner's requirement to avoid the use of impermissible hindsight to assure that the conclusion of obviousness is based on facts gleaned from the prior art).*

Furthermore, even if one of ordinary skill in the art did combine the teachings of Tuttle with those of Conwell, there is no reasonable expectation of success. Tuttle discloses many of the disadvantages associated with using passive RFIDs in a mailing label or postage stamp application but never describes any solutions to these disadvantages. Conwell simply describes a passive system and makes no mention of its applicability to a postage stamp application. Thus, one of ordinary skill in the art, upon reading Tuttle, would conclude that passive tracking devices such as RFIDs are not suitable for a postage stamp.

In addition, even the Examiner, when combining the references, arrived at a device that includes an active RFID and is thus different from the claimed device. Specifically, the Examiner states “it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a passive tracking device as disclosed by Conwell *in addition to* an active tracking device.” *Office action dated August 24, 2005, page 4 (emphasis added).* Such a combination would require two separate RFIDs, thus at least doubling the added cost of each stamp. A combination of elements that results in a device completely unsatisfactory for the

desired task (due to lack of functionality or excessive cost) cannot be obvious. See In re Gordon, 733 F.2d at 902, 221 U.S.P.Q. at 1127.

For these reasons, Applicants submit that Tuttle and Conwell alone or in combination do not teach or suggest the subject matter defined by claim 3. Accordingly, claim 3 is allowable. In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 3 and allowance of claim 3.

B – Rejection of claims 11-17, 19, 22, and 26-28 under 35 U.S.C. §103(a) as being unpatentable over Tuttle in view of Levasseur et al. (U.S. Patent No. 4,008,792), Fite et al. (U.S. Patent No. 6,467,684), and Conwell.

i: **Claims 11-17**

Claims 11-17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Tuttle in view of Levasseur et al. (U.S. Patent No. 4,008,792), Fite et al. (U.S. Patent No. 6,467,684), and Conwell.

Claims 11-17 are patentable separately from the other claims because these claims do not include all the limitations of the other claims and because these claims recite, *inter alia*, a reader operatively associated with a stamp dispenser to read stamp ID information from a passive RFID device attached to the stamp when the relative position between a stamp and the reader changes, and a database operable to store the read stamp ID information. More specifically, claims 11-17 are patentable because the references cited by the Examiner, alone or in combination, fail to teach or suggest all of the claimed limitations, as described below in more detail.

The arguments presented above with regard to claims 1, 3, and 4-7 apply with equal weight to claims 11-17. Rather than repeat the arguments set forth above, Applicants refer to the discussion above for claims 1, 3, and 4-7.

Claim 11 defines a postage stamp dispensing system that includes a plurality of postage stamps. Each stamp includes a tracking device that includes stamp ID information. A stamp dispenser is adapted to contain and dispense the stamps. A reader is operatively associated with the stamp dispenser to read the stamp ID information when the relative position between the stamp and the reader changes. A database is operable to store the read stamp ID information. Each tracking device includes a radio frequency identification (RFID) device. The RFID device is passive.

In the Office action dated October 19, 2004 the Examiner argued that the combination of Tuttle and Conwell teaches the use of a passive RFID as a tracking device for a postage stamp. As discussed with regard to claims 1, 3, and 4-7, Tuttle and Conwell do not teach or suggest that a passive tracking device such as a passive RFID would be suitable as a tracking device for a postage stamp. As such, claims 11-17 are allowable for the reasons set forth with regard to claims 1, 3, and 4-7. In addition, claims 11-17 are separately patentable because these claims recite, *inter alia*, a reader that is operatively associated with the stamp dispenser to read the stamp ID information when the relative position between the stamp and the reader changes.

The Examiner cites Fite as teaching a reader that reads information when the relative position between a dispensed product and a reader changes. Fite discloses a system for selling and dispensing pre-paid cards for purchasing products or services. The cards include magnetic strips that can be read by card readers after the card is dispensed to the customer. However, Fite makes no mention of reading a passive RFID that is positioned on a stamp or other product. Furthermore, Fite does not teach or suggest storing read information in a database. All Fite teaches is that a magnetic strip on a card can be read by a magnetic strip reader. The read data is

then used to activate the card. Nothing in Fite suggests that any of the read data is stored in a database.

The Examiner cites Levasseur as teaching vend control circuits that allow the vending of various quantities of products at different prices. However, Levasseur teaches nothing regarding RFIDs, passive or active. Furthermore, Levasseur does not teach or suggest reading a passive RFID that is positioned on a stamp or other product, or storing the read data in a database.

In addition, even if Tuttle, Fite, Levasseur, and Conwell teach the limitations of claim 11, a contention Applicants disagree with, the Examiner has failed to show any motivation, found within the references themselves, that would lead one of ordinary skill to combine these four references. *See MPEP §2142 (discussing examiner's requirement to avoid the use of impermissible hindsight to assure that the conclusion of obviousness is based on facts gleaned from the prior art).* The Examiner has clearly reconstructed the invention in hindsight by trying to find claim elements in various diverse pieces of prior art, and still required four references to do so.

Applicants have discussed the lack of a motivation to combine Tuttle and Conwell with regard to claims 1, 3, and 4-7 and those arguments are equally applicable to claims 11-17.

The Examiner combined the teachings of Levasseur with those of Tuttle and Conwell and stated that it would have been obvious to combine the teachings to arrive at a vending machine to dispense stamps because “this is an efficient and a convenient way for consumers to be able to purchase stamps when a conventional store is closed.” *Office action dated October 19, 2004, page 6.* The Examiner also states that Levasseur is properly combined with Tuttle and Conwell because Levasseur is from a related field, as “Levasseur teaches the dispensing/vending of stamps.” *Office action dated October 19, 2004, page 15.* Applicants disagree that Levasseur is

from a related field and that Levasseur teaches the dispensing/vending of stamps. Levasseur teaches a vend control circuit and makes no mention of vending stamps. In addition, there is no suggestion in Tuttle, Conwell, or Levasseur that would lead one of ordinary skill in the art to combine these references. The fact that the claimed invention is more efficient and convenient for consumers does not make it obvious to combine references that are selectively culled to show the recited claim limitations.

In an effort to show all of the claimed limitations, the Examiner also combined the teachings of Fite with those of Tuttle, Levasseur, and Conwell. As discussed above, Fite does not teach or suggest the limitations alleged by the Examiner. Furthermore, there is no suggestion in any of the references that would lead one of ordinary skill in the art to combine the teachings of Fite with those of Tuttle, Levasseur, and Conwell. The Examiner stated that it would have been obvious to combine the teachings because “it is favorable to be able to track an object that has been purchased be [sic] a consumer to ensure correct handling and operation.” *Office action dated October 19, 2004, page 8*. The Examiner further states that it would have been obvious to vend stamps and pre-paid cards in the same manner. *See Office action dated October 19, 2004, page 15*. Finally, the Examiner states that Fite is properly combinable with Tuttle, Levasseur, and Conwell as Fite teaches the intricacies of vending objects. *See Office action dated October 19, 2004, page 15*. However, Applicants see no teaching that would suggest stamps could be vended and tracked in a manner similar to that disclosed in Fite. If they were, each stamp would include a magnetic strip to allow for tracking. Furthermore, Fite teaches that the cards are inactive prior to the sale and are activated when read by the card reader. After being activated, the card is comparable to a bank note in the hands of a customer. However, Fite does not teach or suggest tracking the cards after purchase, nor does Fite suggest storing any read data in a

database. Fite only teaches activating the cards. Thus, the Examiner fills in the motivation to combine the references with one of the problems solved by the present invention.

Thus, the Examiner relies on impermissible hindsight and the teachings of the Applicants to arrive at the incorrect conclusion that claim 11 is obvious. *See MPEP §2142 (discussing examiner's requirement to avoid the use of impermissible hindsight to assure that the conclusion of obviousness is based on facts gleaned from the prior art).* The alleged fact that Fite teaches the intricacies of vending objects does not amount to a teaching of employing a reader to read information from stamps as they are vended and a database that stores the read data.

For these reasons, it is submitted that Tuttle, Fite, Levasseur, and Conwell alone or in combination do not teach or suggest the subject matter defined by claim 11. Furthermore, even if Tuttle, Fite, Levasseur, and Conwell did teach all of the limitations of claim 11, a contention Applicants disagree with, there is no suggestion in any of Tuttle, Fite, Levasseur, and Conwell that would lead one of ordinary skill in the art to combine their teachings. Any contention that it would have been obvious to combine these four references to arrive at the invention of claim 11 relies on impermissible hindsight after viewing the Applicants claimed invention, and is improper. *See MPEP §2142 (discussing examiner's requirement to avoid the use of impermissible hindsight to assure that the conclusion of obviousness is based on facts gleaned from the prior art).*

Accordingly, claim 11 is allowable. Claims 12-17 depend from allowable independent claim 11 and are also allowable.

The arguments presented above are applicable to claims 11-17 as they appear without the amendment filed February 14, 2005. Had the Examiner entered this amendment, as Applicants contend should have been done, the phrase “that does not include an onboard power supply”

would be included in claim 11. In addition, the readers operation would have been clarified to recite that the stamp ID information is read as the stamp is dispensed. While the first phrase adds nothing that is not inherently present in the claim language as it is now, the limitation would have clarified the meaning of “passive” and would have clarified the issues for this appeal. In addition, language similar to the second phrase is included in current claims (e.g., claim 19) and as such could no possibly have added new matter. As such, Applicants contend the Examiner should have entered the amendment filed February 14, 2005.

ii: **Claims 19 and 26-28**

Claim 19 defines a method of tracking a postage stamp. The method includes coupling tracking information to the stamp, the tracking information including a stamp ID. The method also includes dispensing the stamp to a customer, reading the tracking information as the stamp is dispensed, and storing the stamp ID in a database. The tracking information is stored within a passive RFID device.

In the Office action dated October 19, 2004 the Examiner argued that the combination of Tuttle and Conwell teaches the use of a passive RFID as a tracking device for a postage stamp. As discussed with regard to claims 1, 3, and 4-7, Tuttle and Conwell do not teach or suggest that a passive tracking device such as a passive RFID would be suitable as a tracking device for a postage stamp. As such, claims 19 and 26-28 are allowable for the reasons set forth with regard to claims 1, 3, and 4-7. In addition, claims 19 and 26-28 are separately patentable because these claims recite, *inter alia*, reading tracking information from a passive RFID coupled to a stamp as the stamp is dispensed to a customer.

The Examiner cites Fite as teaching a reader that reads information when the relative position between a dispensed product and a reader changes. Fite discloses a system for selling and dispensing pre-paid cards for purchasing products or services. The cards include magnetic strips that can be read by card readers after the card is dispensed to the customer. However, Fite makes no mention of reading a passive RFID that is positioned on a stamp or other product, as the product is dispensed. All Fite teaches is that a magnetic strip on a card can be read by a magnetic strip reader after the card has been dispensed to the customer.

The Examiner cites Levasseur as teaching vend control circuits that allow the vending of various quantities of products at different prices. However, Levasseur teaches nothing regarding RFIDs, passive or active. Furthermore, Levasseur does not teach or suggest reading a passive RFID that is positioned on a stamp or other product as the product is dispensed.

In addition, even if Tuttle, Fite, Levasseur, and Conwell teach the limitations of claim 19, a contention Applicants disagree with, the Examiner has failed to show any motivation, found within the references themselves, that would lead one of ordinary skill to combine these four references. *See MPEP §2142 (discussing examiner's requirement to avoid the use of impermissible hindsight to assure that the conclusion of obviousness is based on facts gleaned from the prior art)*. The Examiner has clearly reconstructed the invention in hindsight by trying to find claim elements in various diverse pieces of prior art, and still required four references to do so.

Applicants have discussed the lack of a motivation to combine Tuttle and Conwell with regard to claims 1, 3, and 4-7 and those arguments are equally applicable to claims 19 and 26-28.

The Examiner combined the teachings of Levasseur with those of Tuttle and Conwell and stated that it would have been obvious to combine the teachings to arrive at a vending machine to

dispense stamps because “this is an efficient and a convenient way for consumers to be able to purchase stamps when a conventional store is closed.” *Office action dated October 19, 2004, page 6.* The Examiner also states that Levasseur is properly combined with Tuttle and Conwell because Levasseur is from a related field, as “Levasseur teaches the dispensing/vending of stamps.” *Office action dated October 19, 2004, page 15.* Applicants disagree that Levasseur is from a related field and that Levasseur teaches the dispensing/vending of stamps. Levasseur teaches a vend control circuit and makes no mention of vending stamps. In addition, there is no suggestion in Tuttle, Conwell, or Levasseur that would lead one of ordinary skill in the art to combine these references. The fact that the claimed invention is more efficient and convenient for consumers does not make it obvious. The Examiner has used a perceived advantage of Applicants’ invention as a motivation to combine references that are selectively culled to show the recited claim limitations.

In an effort to show all of the claimed limitations, the Examiner also combined the teachings of Fite with those of Tuttle, Levasseur, and Conwell. As discussed above, Fite does not teach or suggest the limitations alleged by the Examiner. For example, Fite does not teach or suggest reading information from a product as it is dispensed. Rather, Fite discloses a system in which information is read from a card after it is dispensed. Furthermore, there is no suggestion in any of the references that would lead one of ordinary skill in the art to combine the teachings of Fite with those of Tuttle, Levasseur, and Conwell. The Examiner stated that it would have been obvious to combine the teachings because “it is favorable to be able to track an object that has been purchased be [sic] a consumer to ensure correct handling and operation.” *Office action dated October 19, 2004, page 8.* The Examiner further states that it would have been obvious to vend stamps and pre-paid cards in the same manner. *See Office action dated October 19, 2004,*

page 15. Finally, the Examiner states that Fite is properly combinable with Tuttle, Levasseur, and Conwell as Fite teaches the intricacies of vending objects. *See Office action dated October 19, 2004, page 15.* However, Applicants see no teaching that would suggest stamps could be vended and tracked in a manner similar to that disclosed in Fite. If they were, each stamp would include a magnetic strip to allow for tracking. Furthermore, Fite teaches that the cards are inactive prior to the sale and are activated when read by the card reader. After being activated, the card is comparable to a bank note in the hands of a customer. However, Fite does not teach or suggest tracking the cards after purchase, Fite only teaches activating the cards. Thus, the Examiner fills in the motivation to combine the references with one of the problems solved by the present invention.

Thus, the Examiner relies on impermissible hindsight and the teachings of the Applicants to arrive at the incorrect conclusion that claims 19 and 26-28 are obvious. *See MPEP §2142 (discussing examiner's requirement to avoid the use of impermissible hindsight to assure that the conclusion of obviousness is based on facts gleaned from the prior art).* The alleged fact that Fite teaches the intricacies of vending objects does not amount to a teaching of employing a reader to read information from stamps as they are dispensed.

For these reasons, it is submitted that Tuttle, Fite, Levasseur, and Conwell alone or in combination do not teach or suggest the subject matter defined by claims 19 and 26-28. Furthermore, even if Tuttle, Fite, Levasseur, and Conwell did teach all of the limitations of claims 19 and 26-28, a contention Applicants disagree with, there is no suggestion in any of Tuttle, Fite, Levasseur, and Conwell that would lead one of ordinary skill in the art to combine their teachings. Any contention that it would have been obvious to combine these four references to arrive at the invention of claims 19 and 26-28 relies on impermissible hindsight

after viewing the Applicants claimed invention, and is improper. *See MPEP §2142 (discussing examiner's requirement to avoid the use of impermissible hindsight to assure that the conclusion of obviousness is based on facts gleaned from the prior art).*

Accordingly, claim 19 is allowable. Claims 26-28 depend from allowable independent claim 19 and are allowable for the same and other reasons.

The arguments presented above are applicable to claims 19 and 26-28 as they appear without the amendment filed February 14, 2005. Had the Examiner entered this amendment, as Applicants contend should have been done, the phrase “that does not include an onboard power supply” would be included in claim 19. While this phrase adds nothing that is not inherently present in the claim language as it is now, the limitation would have clarified the meaning of “passive” and would have clarified the issues for this appeal. As such, Applicants contend the Examiner should have entered the amendment filed February 14, 2005

iii: Claim 22

Claim 22 depends from claim 19 and adds the step of storing a dispensing location within the database.

The arguments presented above with regard to claims 1, 3, and 4-7 and claims 11-17, 19, and 26-28 apply with equal weight to claim 22. Rather than repeat the arguments set forth above, Applicants refer to the discussion above for claims 1, 3, and 4-7 and claims 11-17, 19, and 26-28.

None of Tuttle, Fite, Levasseur, and Conwell, alone or in combination, teach or suggest each and every limitation of claim 19, much less those of claim 22. In particular, Fite fails to teach or suggest storing the dispensing location within the database. Rather, Fite discloses a

system that reads a card to activate the card and that can store data regarding the use of that card. There is no suggestion of storing data that relates to where the card was sold or dispensed.

Thus, the references cited by the Examiner fail to disclose each and every limitation of claim 22. In addition, as discussed with regard to claims 1, 3, and 4-7 and claims 11-17, 19, and 26-28 there is no motivation to combine the teachings of the cited references, nor is there a likelihood of success if the references were combined.

The Examiner is simply culling the claimed limitations from various references and using impermissible hindsight to find a justification for combining the teachings of Tuttle, Levasseur, Fite, and Conwell. Thus, the Examiner is relying on impermissible hindsight and the teachings of the Applicants' application to arrive at an improper obviousness rejection based on these four references. *See MPEP §2142 (discussing Examiner's requirement to avoid the use of impermissible hindsight to assure that the conclusion of obviousness is based on facts gleaned from the prior art).*

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 22 and allowance of claim 22.

C – Rejection of claims 18 and 20 under 35 U.S.C. §103(a) as being unpatentable over Tuttle in view of Levasseur et al., Fite et al., Conwell, and Barcelou (U.S. Patent No. 6,048,271).

i: **Claim 18**

Claim 18 is patentable separately from the other claims because claim 18 does not include all the limitations of the other claims and because claim 18 recites, *inter alia*, an imaging device associated with the stamp dispenser and operable to capture an image of the user of the stamp dispenser. More specifically, claim 18 is patentable because the references cited by the

Examiner, alone or in combination, fail to teach or suggest all of the claimed limitations, as described below in more detail.

The arguments presented above with regard to claims 1, 3, and 4-7 and claims 11-17, 19, 22, and 26-28 apply with equal weight to claim 18. Rather than repeat the arguments set forth above, Applicants refer to the discussion above for claims 1, 3, and 4-7 and claims 11-17, 19, 22, and 26-28.

Claim 18 depends from claim 11 and adds an imaging device operatively associated with the stamp dispenser to capture an image of the user of the stamp dispenser.

Barcelou does not teach or suggest each and every limitation of claim 11, much less those of claim 18. However, even if Barcelou did teach the limitations of claim 18, a contention Applicants disagree with, there is no suggestion in Barcelou, Tuttle, Levasseur, Fite, or Conwell that would lead one of ordinary skill in the art to combine the teachings of these five references. The Examiner is simply culling the claimed limitations from various references and using impermissible hindsight to find a justification for combining the teachings of Barcelou with those of Tuttle, Levasseur, Fite, and Conwell. Thus, the Examiner is relying on impermissible hindsight and the teachings of the Applicants' application to arrive at an improper obviousness rejection based on these five references. *See MPEP §2142 (discussing Examiner's requirement to avoid the use of impermissible hindsight to assure that the conclusion of obviousness is based on facts gleaned from the prior art).*

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 18 and allowance of claim 18.

ii: **Claim 20**

Claim 20 is patentable separately from the other claims because claim 20 does not include all the limitations of the other claims and because claim 20 recites, *inter alia*, capturing an image of the customer and storing the captured image in a database. More specifically, claim 20 is patentable because the references cited by the Examiner, alone or in combination, fail to teach or suggest all of the claimed limitations, as described below in more detail.

The arguments presented above with regard to claims 1, 3, and 4-7 and claims 11-17, 19, 22, and 26-28 apply with equal weight to claim 20. Rather than repeat the arguments set forth above, Applicants refer to the discussion above for claims 1, 3, and 4-7 and claims 11-17, 19, 22, and 26-28.

Claim 20 depends from claim 19 and adds the step of capturing an image of the customer and storing the captured image in the database.

Barcelou does not teach or suggest each and every limitation of claim 19, much less those of claim 20. Rather, Barcelou teaches of the existence of cameras. However, nothing in Barcelou suggests capturing an image of a user and storing that image in a database. However, even if Barcelou did teach the limitations of claim 20, a contention Applicants disagree with, there is no suggestion in Barcelou, Tuttle, Levasseur, Fite, or Conwell that would lead one of ordinary skill in the art to combine the teachings of these five references. The Examiner is simply culling the claimed limitations from various references and using impermissible hindsight to find a justification for combining the teachings of Barcelou with those of Tuttle, Levasseur, Fite, and Conwell. Thus, the Examiner is relying on impermissible hindsight and the teachings of the Applicants' application to arrive at an improper obviousness rejection based on these five references. *See MPEP §2142 (discussing Examiner's requirement to avoid the use of*

impermissible hindsight to assure that the conclusion of obviousness is based on facts gleaned from the prior art).

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 20 and allowance of claim 20.

D – Rejection of claims 23-25 under 35 U.S.C. §103(a) as being unpatentable over Tuttle in view of Levasseur et al., Fite et al., Conwell, and Porter (U.S. Patent No. 5,774,053).

i: **Claim 23**

Claim 23 is patentable separately from the other claims because the claim does not include all the limitations of the other claims and because the claim recites, *inter alia*, the step of reading tracking information from a stamp as the stamp is deposited in a mailbox. More specifically, claim 23 is patentable because the references cited by the Examiner, alone or in combination, fail to teach or suggest all of the claimed limitations, as described below in more detail.

Claim 23 depends from claim 19 and adds the step of reading the tracking information as the stamp is deposited into a postal mailbox, and storing the stamp ID and a mailbox location within a database. The arguments presented above with regard to claims 1, 3, and 4-7 and claims 11-17, 19, 22, and 26-28 apply with equal weight to claim 23. Rather than repeat the arguments set forth above, Applicants refer to the discussion above for claims 1, 3, and 4-7 and claims 11-17, 19, 22, and 26-28. In addition to the arguments set forth above, claim 23 is allowable because Porter does not teach or suggest reading tracking information from a stamp as the stamp is deposited in a postal mailbox. Rather, Porter discloses a storage device that provides secure access to a space. A user places goods for delivery in the secured space after unlocking a lock actuator. To unlock the actuator, the user provides user information in the form

of a key code, contactless smart card, or other device. Thus, Porter teaches a device that uses and stores user information to provide tracking and access control for a space. Porter does not teach or suggest reading a passive RFID that is attached to a stamp as the stamp is placed in the space. In fact, Porter does not teach or suggest reading any information associated with, or attached to the object being placed in the space.

Furthermore, even if Porter did teach the limitations of claim 23, a contention Applicants disagree with, there is no suggestion in Porter, Tuttle, Levasseur, Fite, or Conwell that would lead one of ordinary skill in the art to combine the teachings of these five references. The Examiner argues that it would have been obvious to combine Porter with Tuttle, Levasseur, Fite, and Conwell because Porter is from a related field “(i.e., . . . Porter teaches confirmation of a delivery of an object).” *Office action dated October 19, 2004, page 15*. However, Porter teaches nothing regarding a postal mailbox, a stamp, an RFID, or any other feature of the claimed invention and is not related in any way. Thus, Applicants are unable to find any suggestion in Porter, Tuttle, Levasseur, Fite, or Conwell that would lead one of ordinary skill in the art to combine these five references. The Examiner is simply culling limitations from various references and using impermissible hindsight in an effort to justify combining their teachings. It is the invention of the trackable postage stamp that creates the ability to read tracking information from the stamp as the stamp is deposited in the mailbox. Without the Applicants’ invention, the ability and desire to read tracking information from a stamp would not exist. Thus, the Examiner is relying on impermissible hindsight and the teachings of the Applicants’ invention to arrive at an obviousness rejection based on these five references. *See MPEP §2142 (discussing examiner’s requirement to avoid the use of impermissible hindsight to assure that the conclusion of obviousness is based on facts gleaned from the prior art)*. The Examiner has

clearly reconstructed the invention in hindsight by trying to find claim elements in various diverse pieces of prior art, and still required five references to do so.

For these reasons, it is submitted that Tuttle, Levasseur, Fite, Conwell, and Porter, alone or in combination do not teach or suggest the subject matter defined by claim 23. Furthermore, even if Tuttle, Fite, Levasseur, Conwell, and Porter did teach all of the limitations of claim 23, a contention Applicants disagree with, there is no suggestion in any of Tuttle, Fite, Levasseur, Conwell, or Porter that would lead one of ordinary skill in the art to combine their teachings. Any contention that it would have been obvious to combine these five references to arrive at the invention of claim 23 relies on impermissible hindsight after viewing the Applicants' claimed invention, and is improper. *See MPEP §2142 (discussing examiner's requirement to avoid the use of impermissible hindsight to assure that the conclusion of obviousness is based on facts gleaned from the prior art).*

Accordingly, claim 23 is allowable. Applicants respectfully request reconsideration and withdrawal of the rejection of claim 23 and allowance of claim 23.

ii: **Claim 24**

Claim 24 is patentable separately from the other claims because the claim does not include all the limitations of the other claims and because the claim recites, *inter alia*, the steps of comparing the mailbox location and the dispensing location, and identifying the stamp if the mailbox location is more than a predefined distance from the dispensing location. More specifically, claim 24 is patentable because the references cited by the Examiner, alone or in combination, fail to teach or suggest all of the claimed limitations, as described below in more detail.

Claim 24 depends from claim 23 and adds the steps of comparing the mailbox location and the dispensing location, and identifying the stamp if the mailbox location is more than a predefined distance from the dispensing location. The arguments presented above with regard to claims 1, 3, and 4-7, claims 11-17, 19, 22, and 26-28, and claim 23 apply with equal weight to claim 24. Rather than repeat the arguments set forth above, Applicants refer to the discussion above for claims 1, 3, and 4-7, claims 11-17, 19, 22, and 26-28, and claim 23. In addition to the arguments set forth above, claim 24 is allowable because Porter does not teach or suggest comparing the mailbox location and the dispensing location, and identifying the stamp if the mailbox location is more than a predefined distance from the dispensing location. In fact, Porter makes no mention of comparing the location of the space with any location associated with the object disposed in the space. The Examiner also fails to find an explicit teaching within Porter, and instead states:

[i]n view of the teaching of Porter, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a system to be able to confirm the delivery of the articles with the trackable stamps to ensure that a correct delivery was made (this includes determining if the mailbox location is more than a predefined distance from the dispensing location).

Office action dated October 19, 2004, page 13. Applicants cannot find this teaching within Porter and conclude that even with the combination of five references, the Examiner is still unable to find a teaching of all of the limitations of claim 24.

Furthermore, even if Porter did teach the limitations of claim 24, a contention Applicants disagree with, there is no suggestion in Porter, Tuttle, Levasseur, Fite, or Conwell that would lead one of ordinary skill in the art to combine the teachings of these five references. For the reasons set forth with regard to claim 23, the teachings of Porter cannot be combined with those of Tuttle, Levasseur, Fite, and Conwell without the use of impermissible hindsight. *See MPEP*

§2142 (discussing examiner's requirement to avoid the use of impermissible hindsight to assure that the conclusion of obviousness is based on facts gleaned from the prior art). The Examiner has clearly reconstructed the invention in hindsight by trying to find claim elements in various diverse pieces of prior art, and still required five references to do so.

For these reasons, it is submitted that Tuttle, Levasseur, Fite, Conwell, and Porter, alone or in combination do not teach or suggest the subject matter defined by claim 24. Furthermore, even if Tuttle, Fite, Levasseur, Conwell, and Porter did teach all of the limitations of claim 24, a contention Applicants disagree with, there is no suggestion in any of Tuttle, Fite, Levasseur, Conwell, or Porter that would lead one of ordinary skill in the art to combine their teachings. Any contention that it would have been obvious to combine these five references to arrive at the invention of claim 24 relies on impermissible hindsight after viewing the Applicants' claimed invention, and is improper. *See MPEP §2142 (discussing examiner's requirement to avoid the use of impermissible hindsight to assure that the conclusion of obviousness is based on facts gleaned from the prior art).*

Accordingly, claim 24 is allowable. Applicants respectfully request reconsideration and withdrawal of the rejection of claim 24 and allowance of claim 24.

iii: Claim 25

Claim 25 is patentable separately from the other claims because the claim does not include all the limitations of the other claims and because the claim recites, *inter alia*, the steps of comparing the mailbox location and the dispensing location, and identifying the stamp if the mailbox location is more than a predefined distance from the dispensing location. More specifically, claim 25 is patentable because the references cited by the Examiner, alone or in

combination, fail to teach or suggest all of the claimed limitations, as described below in more detail.

Claim 25 depends from claim 19 and adds the steps of sensing when an article is deposited in a mailbox, determining when tracking information was not properly read for all the articles placed in the mailbox, and providing a perceivable indication when it has been determined that tracking information was not properly read for all the articles placed in the mailbox. The arguments presented above with regard to claims 1, 3, and 4-7 and claims 11-17, 19, 22, and 26-28 apply with equal weight to claim 25. Rather than repeat the arguments set forth above, Applicants refer to the discussion above for claims 1, 3, and 4-7 and claims 11-17, 19, 22, and 26-28. In addition to the arguments set forth above, claim 25 is allowable because Porter does not teach or suggest reading any information from the object being placed in the space, much less identifying that information has not been properly read from one or more objects. Porter teaches a device that reads data associated with the user accessing the space. Porter does not teach reading information from an object that is being placed in the space.

Furthermore, even if Porter did teach the limitations of claim 25, a contention Applicants disagree with, there is no suggestion in Porter, Tuttle, Levasseur, Fite, or Conwell that would lead one of ordinary skill in the art to combine the teachings of these five references. For the reasons set forth with regard to claims 1, 3, and 4-7, claims 11-17, 19, 22, and 26-28, claim 23, and claim 24, the teachings of Porter cannot be combined with those of Tuttle, Levasseur, Fite, and Conwell without the use of impermissible hindsight. *See MPEP §2142 (discussing examiner's requirement to avoid the use of impermissible hindsight to assure that the conclusion of obviousness is based on facts gleaned from the prior art).*

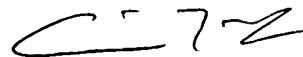
For these reasons, it is submitted that Tuttle, Levasseur, Fite, Conwell, and Porter, alone or in combination do not teach or suggest the subject matter defined by claim 25. Furthermore, even if Tuttle, Fite, Levasseur, Conwell, and Porter did teach all of the limitations of claim 25, a contention Applicants disagree with, there is no suggestion in any of Tuttle, Fite, Levasseur, Conwell, or Porter that would lead one of ordinary skill in the art to combine their teachings. Any contention that it would have been obvious to combine these five references to arrive at the invention of claim 25 relies on impermissible hindsight after viewing the Applicants claimed invention, and is improper. *See MPEP §2142 (discussing examiner's requirement to avoid the use of impermissible hindsight to assure that the conclusion of obviousness is based on facts gleaned from the prior art).* The Examiner has clearly reconstructed the invention in hindsight by trying to find claim elements in various diverse pieces of prior art, and still required five references to do so.

Accordingly, claim 25 is allowable. Applicants respectfully request reconsideration and withdrawal of the rejection of claim 25 and allowance of claim 25.

(8) Conclusion

In view of the foregoing, Applicants respectfully request reversal of the final rejection of claims 1, 3-7, 11-20, and 22-28 and allowance of claims 1, 3-7, 11-20, and 22-28.

Respectfully submitted,



Casimir F. Laska
Reg. No. 30,862

Docket No.: 061151-9010-00
Michael Best & Friedrich LLP
100 East Wisconsin Avenue

Milwaukee, Wisconsin 53202-4108
(262) 956-6523

APPENDIX A

Listing of Claims:

What is claimed is:

1. (Original) A trackable postage stamp comprising:
 - a first surface;
 - a second surface opposite the first surface and adapted to adhere to a piece of mail; and
 - a passive tracking device including stamp identification (ID) information.
2. (Cancelled)
3. (Original) The postage stamp of claim 1, wherein the passive tracking device includes a radio frequency identification (RFID) device.
4. (Original) The postage stamp of claim 1, wherein the stamp ID information includes encrypted data corresponding to at least two of a date, a location, a postage value, and a unique designation.
5. (Original) The postage stamp of claim 4, wherein encrypted data are combined to at least partially yield the stamp ID information.
6. (Original) The postage stamp of claim 1, wherein the passive tracking device is coupled to one of the first surface and the second surface.

7. (Original) The postage stamp of claim 1, wherein the stamp identification (ID) information is unique to each stamp.

8-10 (Cancelled)

11. (Previously Presented) A postage stamp dispensing system comprising:
a plurality of postage stamps, each stamp including a tracking device that includes
stamp ID information;
a stamp dispenser adapted to contain and dispense the stamps;
a reader operatively associated with the stamp dispenser to read the stamp ID
information when the relative position between the stamp and the reader changes; and
a database operable to store the read stamp ID information, wherein each tracking device
includes a radio frequency identification (RFID) device, and wherein the RFID device is passive.

12. (Previously Presented) The system of claim 11, wherein the stamp ID information
includes encrypted data corresponding to at least two of a date, a location, a postage value, and a
unique designation.

13. (Original) The postage stamp of claim 12, wherein encrypted data are combined
to at least partially yield the stamp ID information.

14. (Original) The system of claim 13, wherein the encrypted data that makes up the
stamp ID information is stored as separate values in the database.

15. (Original) The system of claim 12, wherein the dispenser is a vending machine
and the device reader is part of the vending machine.

16. (Original) The system of claim 12, wherein a portion of the plurality of stamps are arranged in a book and the book includes book identification data.

17. (Original) The system of claim 16, wherein the reader is operable to read the book identification data and the database is operable to store the book identification data.

18. (Previously Presented) The system of claim 11, further comprising an imaging device operatively associated with the stamp dispenser to capture an image of the user of the stamp dispenser.

19. (Previously Presented) A method of tracking a postage stamp, the method comprising:

coupling tracking information to the stamp, the tracking information including a stamp ID;

dispensing the stamp to a customer;

reading the tracking information as the stamp is dispensed; and

storing the stamp ID in a database,
wherein the tracking information is stored within a passive RFID device.

20. (Original) The method of claim 19, further comprising capturing an image of the customer and storing the captured image in the database.

21. (Cancelled)

22. (Original) The method of claim 19, further comprising storing a dispensing location within the database.

23. (Original) The method of claim 19, further comprising reading the tracking information as the stamp is deposited into a postal mailbox, and storing the stamp ID and a mailbox location within a database.

24. (Original) The method of claim 23, further comprising comparing the mailbox location and the dispensing location, and identifying the stamp if the mailbox location is more than a predefined distance from the dispensing location.

25. (Original) The method of claim 19, further comprising sensing when an article is deposited in a mailbox; determining when tracking information was not properly read for all the articles placed in the mailbox; and providing a perceivable indication when it has been determined that tracking information was not properly read for all the articles placed in the mailbox.

26. (Original) The method of claim 19, wherein the dispensing step includes dispensing the stamp as part of a book of stamps, and wherein the book includes book identification information.

27. (Original) The method of claim 26, wherein the reading step also includes reading the book identification information, and the storing step also includes storing the book ID in the database.

28. (Original) The method of claim 27, wherein the database includes a list of individual stamp IDs associated with the book ID.

APPENDIX B

Evidence:

None.

APPENDIX C

Related Proceedings:

None.

APPENDIX D

Listing of Claims:

What is claimed is:

1. (Currently Amended) A trackable postage stamp comprising:
 - a first surface;
 - a second surface opposite the first surface and adapted to adhere to a piece of mail; and
 - a passive tracking device without an onboard power supply and including stamp identification (ID) information, wherein the passive tracking device includes a radio frequency identification device (RFID).
2. (Cancelled)
3. (Cancelled)
4. (Original) The postage stamp of claim 1, wherein the stamp ID information includes encrypted data corresponding to at least two of a date, a location, a postage value, and a unique designation.
5. (Original) The postage stamp of claim 4, wherein encrypted data are combined to at least partially yield the stamp ID information.

6. (Original) The postage stamp of claim 1, wherein the passive tracking device is coupled to one of the first surface and the second surface.

7. (Original) The postage stamp of claim 1, wherein the stamp identification (ID) information is unique to each stamp.

8-10. (Cancelled)

11. (Currently Amended) A postage stamp dispensing system comprising:

a plurality of postage stamps, each stamp including a tracking device that includes stamp ID information;

a stamp dispenser adapted to contain and dispense the stamps;

a reader operatively associated with the stamp dispenser to read the stamp ID information when the relative position between the stamp and the reader changes as the stamp is dispensed; and

a database operable to store the read stamp ID information, wherein each tracking device includes a radio frequency identification (RFID) device that does not include an onboard power supply, and wherein the RFID device is passive.

12. (Previously Presented) The system of claim 11, wherein the stamp ID information includes encrypted data corresponding to at least two of a date, a location, a postage value, and a unique designation.

13. (Original) The postage stamp of claim 12, wherein encrypted data are combined to at least partially yield the stamp ID information.

14. (Original) The system of claim 13, wherein the encrypted data that makes up the stamp ID information is stored as separate values in the database.

15. (Original) The system of claim 12, wherein the dispenser is a vending machine and the device reader is part of the vending machine.

16. (Original) The system of claim 12, wherein a portion of the plurality of stamps are arranged in a book and the book includes book identification data.

17. (Original) The system of claim 16, wherein the reader is operable to read the book identification data and the database is operable to store the book identification data.

18. (Previously Presented) The system of claim 11, further comprising an imaging device operatively associated with the stamp dispenser to capture an image of the user of the stamp dispenser.

19. (Currently Amended) A method of tracking a postage stamp, the method comprising:

coupling tracking information to the stamp, the tracking information including a stamp ID;

dispensing the stamp to a customer;

reading the tracking information as the stamp is dispensed; and

storing the stamp ID in a database,

wherein the tracking information is stored within a passive RFID device that does not include an onboard power supply.

20. (Original) The method of claim 19, further comprising capturing an image of the customer and storing the captured image in the database.

21. (Cancelled)

22. (Original) The method of claim 19, further comprising storing a dispensing location within the database.

23. (Original) The method of claim 19, further comprising reading the tracking information as the stamp is deposited into a postal mailbox, and storing the stamp ID and a mailbox location within a database.

24. (Original) The method of claim 23, further comprising comparing the mailbox location and the dispensing location, and identifying the stamp if the mailbox location is more than a predefined distance from the dispensing location.

26. (Original) The method of claim 19, further comprising sensing when an article is deposited in a mailbox; determining when tracking information was not properly read for all the articles placed in the mailbox; and providing a perceivable indication when it has been determined that tracking information was not properly read for all the articles placed in the mailbox.

26. (Original) The method of claim 19, wherein the dispensing step includes dispensing the stamp as part of a book of stamps, and wherein the book includes book identification information.

27. (Original) The method of claim 26, wherein the reading step also includes reading the book identification information, and the storing step also includes storing the book ID in the database.

28. (Original) The method of claim 27, wherein the database includes a list of individual stamp IDs associated with the book ID.